

REMARKS

The issues outstanding the Office Action mailed July 18, 2007, are the Requirement for Restriction, and the rejections under 35 U.S.C. §101 and §112. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Rejections under 35 U.S.C. §101 and §112

Claims 23-28 have been rejected under 35 U.S.C. §112, first and second paragraphs, and under 35 U.S.C. §101. It is submitted that reformulation of these claims as proper method claims in consideration of U.S. practice obviates all these issues, and withdrawal thereof is therefore respectfully requested.

Requirement for Restriction

The Requirement for Restriction has been maintained, and claims 1-21 and 23-28 have been objected to for containing non-elected subject matter, i.e., compounds and methods, wherein X is O. Applicants' traverse of the Requirement for Restriction is respectfully maintained.

As noted in the present Office Action, at page 4, Annex B of the PCT guide indicates that the Markush claim "meets the special technical feature" for unity of invention when (A) all alternatives have a common property or activity and (B) a common structure is present or all alternatives belong to a recognized class of chemical compounds. It is important to note that in this definition, novelty over the prior art is *not* determinative of unity of invention. See, for example, the PTO's own discussion in the last portion of paragraph 6 at page 4 of the Office Action. It is argued, in the paragraph bridging pages 4 and 5 of the Office Action, that the compounds of the claims do not contain a significant structural element as a special technical feature *which defines a contribution over the prior art*. As admitted in the prior paragraph, however, such is not necessary. The present claims do, in fact, contain a significant structural element, in that all compounds contain the fused ring structure, for example, as shown in claim 1. The only difference between the two groups of claims, in fact, is alleged to be the definition of X as oxygen or sulfur. Such a minor difference, one atom in

a heterocyclic ring, clearly does not eliminate the significant structural feature of the claimed compounds, and thus, makes it clearly evident that a special technical feature providing unity of invention is present in all groups of claims. Withdrawal of the Restriction Requirement is strongly urged.

The claims in the application are submitted to be in condition for allowance. However, if the examiner has any questions or comments, she is cordially invited to telephone the undersigned at the number below.

No fee is believed due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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